UNITED STATES PATENT AND TRADEMARK OFFICE

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2132	

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DATE MAILED: 09/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/847,709	MOSER, MARVIN
	Examiner	Art Unit	
	Jung Kim	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 August 2006</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>56-68</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>56-68</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail. Date _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

1.   This Office action is in response to the amendment filed on August 10, 2006.

2.   Claims 56-68 are pending.

Response to Amendment

3.   The objection to claim 66 is withdrawn as the amendment overcomes the objection.

4.   The 112/2nd paragraph rejections are withdrawn as the amendment overcomes the 112/2nd paragraph rejections.

Response to Arguments

5.   Applicant's arguments regarding the prior art rejections have been fully considered but they are not persuasive.

6.   Applicant's argument as presented in the "Remarks", under the section "Paragraph 12". A. (i) [p. 5-6], are deficient for two reasons. First, applicant argues, "Korn at col. 3, lines 15-18 discloses such hypertext object would reference an original script with appended hash commands, not an encrypted script. The hashed commands and the original script subsequently may be encrypted to hide a public key protecting the hashed commands appended to the script. Korn does not teach a worker skilled in the art to store an encrypted script." However, it appears that applicant's reading of

Korn ignores more relevant portions of the disclosure. On col. 2:25-35 and col. 3:15-18,

Korn teaches

> In one embodiment of the invention, a script in a World Wide Web page ("Web page", "Web
>
> document", or "HyperText Markup Language (HTML) document") is hashed and encrypted. A
>
> control in the Web page, such as ActiveX, decrypts and hashes the script to verify the script has
>
> not been altered or tampered with, before executing or causing to execute the script. In this
>
> manner, one can serve to a client web pages that contain interactive content or that execute local
>
> applications in a secure fashion. The described embodiment involves a script that may be
>
> invoked by a Web browser application, or more particularly, by a control in a Web page
>
> downloaded by the Web browser application.... The script, including the signed hashed values
>
> and public key, if present, may be encrypted using a symmetric key 107 to provide a second level
>
> of encryption.

Clearly, contrary to applicant's allegations, Korn expressly discloses storing an

encrypted script ["a script in a World Wide Web page ('Web page', 'Web document', or

'HyperText Markup Language (HTML) document') is hashed and encrypted."]

Second, the argument is piecemeal and it does not consider the teachings of

W3C. One cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed.

Cir. 1986). W3C discloses incorporating a hypertext object within an HTML page to

invoke remotely located objects to enable greater flexibility to store and retrieve

programs and data sets. Section 13.3 and 13.4. It is the combined teachings of Korn

and W3C that disclose the limitation in question.

7.   With respect to applicants arguments under section Paragraph 12:A(ii) and (iii),

applicant suggests the following: "Korn at col. 3, lines 35-37 discloses a user visiting a

web server [and the user] downloads a web page containing interactive content. Korn

does not disclose a user sending a request to a web server," and "[t]here is no basis in

Korn for the web server to receive a URL and fetch a modified web page. The user

completes this task by visiting the web site and downloading the web page containing

interactive controls." It appears applicant is making the distinction that the step of

"visiting a web server" or "visiting the web site and downloading the web page" are

distinct from the actions of "a user sending a request to a web server" and "the web

server to receive a URL" to fetch a web page. However, applicant supplies no rational

as to why such a distinction exists. The invention of Korn is describing a transaction

between a web server serving HTML web pages with embedded controls in the web

page to decrypt an encrypted script, and a web browser, which receives the modified

web page from the server. In this transaction, applicant's alleged distinction does not

exist. A user visiting a web server to download a web page containing interactive

content *via a web browser* (Korn, col. 2:33-35) necessarily sends a request to a web

server. For example, when a user visits a web site and downloads a web page, he or

she enters a URL into their browser to "visit" the site, and the web server receives this

URL request. This step is equivalent to "sending a request to a web server" and the

"web server to receive a URL."

8.   With respect to applicant's arguments under section Paragraph 12:A(iv-viii),

again, these are piecemeal arguments and they do not consider the teachings of Korn

as modified by W3C. The teachings of the two references and the reasons to combine

are supplied below in the rejections.

9.   With respect to applicant's arguments under section Paragraph 12:A(ix), the

teaching of the prior art is considered in terms of its whole. There is nothing in the prior

art or in the Specification of applicant's invention to suggest that because Korn

discloses additional features beyond what is claimed by applicant, Korn is irrelevant.

On the contrary, Korn is relevant because it teaches those features specifically claimed

by the applicant.

        Further, in reply to applicant's argument that Korn modified by W3C is

inoperative, applicant does not provide a sufficient rational for this argument.

Applicant's claim that the modification is inoperative due to performing unnecessary

steps is not a sufficient basis for being inoperable. In general, an invention can perform

superfluous steps and still remain operable. Rather, the performance of unnecessary

steps is an issue that suggests an undesirableness to combine two references. With

regard to the desirability to combine the two references, the motivation to combine the

two references is addressed both above and below. Furthermore, in reply to applicant's

claim that the modification is inoperative due to the absence of cryptographic key

functions in encrypting and decrypting hash commands and the script, a runtime

environment to decrypt the hash command and the script, and the absence of a

comparator to decrypt the script, the test for obviousness is not whether the features of

a secondary reference may be bodily incorporated into the structure of the primary

reference; nor is it that the claimed invention must be expressly suggested in any one or

all of the references. Rather, the test is what the combined teachings of the references

would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d

413, 208 USPQ 871 (CCPA 1981). Moreover, the combination of Korn and W3C are

readily combinable, contrary to applicant's allegation. W3C discloses, inter alia, means

to incorporate references to a remote object into an *HTML page*. This means is

suggested as a modification within a web page separate from the concerns of the

environmental setup to express the web page. There is nothing in the art to suggest

that incorporating the teachings of W3C into the scheme of Korn would render the

invention inoperable. Hence, because Korn discloses encryption and decryption

techniques on a web script in the context of an HTML web page, as well as runtime

environments for these cryptographic procedures, and storage and retrieval of these

encrypted web scripts, the combination of Korn and W3C cover the limitation of the art.

For the aforementioned reasons, applicant's arguments against the rejection of

claim 56 are not persuasive.

Applicant's arguments with regard to the rejections of claims 57-61 and 67-68 are

unconvincing for the same reasons state above. Hence, these claims remain rejected

under the prior art of record.

In reply to applicant's argument that the prior art does not suggest modifying

Korn to perform concurrent tasks in the manner described by claims 62-64, examiner

disagrees. The rejections below are based on the combined teachings of Korn, W3C

and Hall, wherein Hall explicitly discloses performing concurrent tasks for the purpose of

maintaining efficiency and convenience. Moreover, the examples by Hall illustrate

multi-tasking based on discrete tasks (pgs. 752-760, listings 14.4, 14.10 and 14.12),

which suggest multi-tasking individual steps. Because Korn and W3C combined

disclose the individual steps of applicant's claimed invention, and Hall provides

motivation to perform separate steps in a concurrent manner, the prior art of record

disclose the inventions of claims 62-66.

For these reasons, the applicant's arguments are not persuasive and the claims

remain rejected under the prior art of record.

It is noted that applicant states "[t]he rejection [to the claims] contravenes the

comments made by the Examiner and Supervisory Examiner at the Interview conducted

September 21, 2005 that describing multiple downloads in the claims would overcome

the cited art." (Remarks, p. 12) As a point of clarification, no such statement was made

by either the examiner or the supervisor. During the interview of September 21, 2005,

applicant's representative suggested the aforementioned amendments to the claims to

overcome the references of the prior art. The response of both the examiner and the

supervisor was that consideration to the proposed amendments would be given to an

RCE due to the fact that the amendments are new issues that would require further

search and consideration. This is consistent with the interview summary mailed on
9/21/06.

Claim Rejections - 35 USC § 103

10.   Claims 56-61, 67 and 68 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Korn U.S. Patent No. 6,880,083 (hereinafter Korn) in view of W3C
HTML 4.01 Specification (hereinafter W3C).

11.   As per claim 56, Korn discloses a method executable in a computer for restricting
access to a script in a computer comprising the steps of:

   a.   storing a modified web page in a web server including a hypertext object
having a reference to a decryption program (col. 2:14-30 and lines 34-35; 3:32
and lines 37-38);

   b.   storing an encrypted script in a web server and storing a decryption
program on a server capable of decrypting the encrypting script (Korn, col. 2:14-
30; 3:15-20, 30-33);

   c.   sending a first URL request to the web server for the modified web page
by a web browser in a computer (3:36);

   d.   receiving the first URL request at the web server and fetching the modified
web page for a first download to the web browser, wherein a user's browser
downloads the encrypted script and the decryption program (Korn, 3:36-38);

e.   decrypting the encrypted script by the run-time environment to produce a

script for transmittal to and execution by the web browser (Korn, 3:59-60; an

applet runs in a JRE).

2.   Korn does not expressly teach the hypertext object including a reference to the

encrypted script, nor does Korn explicitly disclose the steps of sending a second and

third URL request and receiving the second and third URL request as recited in claim

56. W3C teaches incorporating a hypertext object within an html page to invoke

remotely located objects that perform dynamic tasks, including functions defined by

applets; furthermore, the hypertext object includes parameters to identify the location of

remote data read in by the objects to perform the dynamic tasks (section 13.3,

especially section 13.3.1 "Rules for rendering objects" and 13.3.2 "Object initialization:

the PARAM element"; section 13.4). In this prior art, objects such as applets are

rendered in the following order: a user agent first renders the object (pg. 8 of section

13.3.1 "Rules for rendering objects," "The user agent must first try to render the object"),

and when the object is rendered, the user agent searches for PARAM elements as

parameters for the objects (pg. 12 of section 13.3.2 "Object initialization: the PARAM

element," "When an OBJECT element is rendered, user agents must search the content

for only those PARAM elements that are direct children and "feed" them to the

OBJECT") In one example, a hypertext object in a modified web page (the <OBJECT>

tag in an html page) references the object using a URL ("<OBJECT

classid="http://www.gifstuff.com/gifappli" [first line of pg. 12 of section 13]) and also

references the run-time data to "feed" into the object as a URI

("value="./images/elvis.gif" [4th line of pg. 12 of section 13]). It would be obvious to one

of ordinary skill in the art at the time the invention was made to store a hypertext object

including a reference to the encrypted script (OBJECT tag) in a modified web page and

a reference to the decryption program (PARAM attributes), whereby access for

restricting access to the script includes the following steps: sending a second URL

request to the web server initiated by the user for the decryption program (Korn, 3:38:

"clicking on an applet"); receiving the second URL request at the web server and

fetching the decryption program for a second download to the web browser (classid and

codebase attributes define URIs to request and retrieve the object); retrieving the URL

reference to the encrypted script in the modified web page by the web browser; sending

a third URL request to the web server initiated by a runtime environment for the

encrypted script; and receiving the third URL request by the web server and fetching the

encrypted script for a third download to the run-time environment (PARAM attribute

value is a URI designating a resource [last line of page 11 of section 13]; applets are

rendered and run in a JRE). One would be motivated to do so since the invocation of

remote objects and remote data sets using hypertext enables access to dynamic

programs and data sets from a remote location, which enables greater flexibility to store

and retrieve programs and data sets (W3C, ibid). The aforementioned cover the

limitations of claim 56.

3.   As per claim 57, the rejection of claim 56 under 35 USC 103(a) as being

unpatentable over Korn in view of W3C is incorporated herein. (supra) In addition, Korn

and W3C further teach or suggest detecting in the first download by the web browser a URL reference in the modified web page to a decryption program (Korn, col. 3:37-38; W3C, pg. 9 of section 13, "classid").

4.   As per claim 58, the rejection of claim 56 under 35 USC 103(a) as being unpatentable over Korn in view of W3C is incorporated herein. (supra) In addition, Korn and W3C further teach or suggest detecting in the second download by the web browser a URL reference to an encrypted script in the modified web page (Korn, col. 3:37-38; W3C, pg. 12 of section 13, "PARAM" and "value="./images/elvis.gif">").

5.   As per claim 59, the rejection of claim 56 under 35 USC 103(a) as being unpatentable over Korn in view of W3C is incorporated herein. (supra) In addition, Korn and W3C further teach or suggest invoking the decryption program with the reference to the encrypted script by the web browser for execution by the run-time environment. (Korn, col. 3:37-38, an applet runs in a JRE)

6.   As per claim 60, the rejection of claim 56 under 35 USC 103(a) as being unpatentable over Korn in view of W3C is incorporated herein. (supra) In addition, Korn and W3C further teach or suggest the web browser is a multi-tasking browser (Korn, col. 1:12-13; 2:35: IE is a multi-tasking browser).

7.   As per claim 61, the rejection of claim 56 under 35 USC 103(a) as being

unpatentable over Korn in view of W3C is incorporated herein. (supra) In addition, Korn

and W3C further teach or suggest the run-time environment is a multi-tasking run-time

environment (applets run in an JRE, which is a multi-tasking run-time environment).

8.   As per claims 67 and 68, they are claims corresponding to claims 56-59, and

they do not teach or define above the information claimed in claims 56-59. Therefore,

claims 67 and 68 are rejected as being unpatentable over Korn in view of W3C for the

same reasons set forth in the rejections of claims 56-59.

12.   Claims 62-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Korn in view of W3C, and further in view of Hall CORE Web Programming, Chapter 14,

"Concurrent Programming using JAVA Threads" (hereinafter Hall).

9.   As per claims 62-66, the rejection of claim 60 under 35 USC 103(a) as being

unpatentable over Korn in view of W3C is incorporated herein. (supra) Neither Korn nor

W3C explicit disclose or suggest launching concurrent tasks by the multi-tasking

browser when the web page is loaded into the web browser; wherein the first concurrent

task sends the second URL request to the web server for the decryption program;

wherein the second concurrent task sends the third URL request to the web server for

the encrypted script; wherein the multi-tasking runtime environment suspends to wait for

the multi-tasking runtime environment to detect that the multitasking web browser has

stored the encrypted script; wherein the multi-tasking browser triggers the multitasking

runtime environment to synchronize the first and the second concurrent task by

detecting the availability of the encrypted script. However, multitasking is a notoriously

well-known means in the art to configure tasks within an application to enable the

benefits of concurrent programming. For example, Hall discloses utilizing threads within

an applet run on a Netscape Browser to perform concurrent tasks for the purpose of

efficiency and convenience (pg. 749, introduction and pgs. 750-760; pgs. 770). Hall

further discloses arbitrating contention for resources by locking code for a given thread

and notifying other thread when the lock is released by the given thread; this process

ensures that the locked code is available only when the thread locking the code is

finished executing the code, which prevents improper execution of the code (pg. 760-

762; pg. 766, "notify()" and "notifyAll()") In the case of the tasks for submitting the URLs

for the decryption program and the encrypted script, these are atomic tasks that do not

require a necessary order for proper operation, and hence, concurrent submission of

the URL for the decryption program and encrypted script are obvious variants in view of

Hall. Moreover, the step of suspending the runtime environment to detect multitasking

web browser has stored the encrypted script, wherein the multitasking browser triggers

the runtime environment to synchronize the first and second concurrent task by

detecting the availability of the encrypted script is an obvious enhancement since

decryption of the script can only proceed when the encrypted script is available locally

within the browser. Therefore, it would be obvious to one of ordinary skill in the art at

the time the invention was made to launch concurrent tasks by the multi-tasking

browser when the web page is loaded in to the web browser; wherein the first

concurrent task sends the second URL request to the web server for the decryption

program; wherein the second concurrent task sends the third URL request to the web

server for the encrypted script; wherein the multi-tasking runtime environment suspends

to wait for the multi-tasking runtime environment to detect that the multitasking web

browser has stored the encrypted script; wherein the multi-tasking browser triggers the

multitasking runtime environment to synchronize the first and the second concurrent

task by detecting the availability of the encrypted script. One would be motivated to do

so to perform the task more quickly in a multithreaded environment and for the sake of

convenience. (Hall, pg. 749) The aforementioned cover the limitations of claims 62-66.

Conclusion

1.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Communications Inquiry

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jung W. Kim whose telephone number is 571-272-3804.

The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Jk
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